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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,566	12/12/2001	Naohiro Takemoto	033025-002	4857
21839	7590	12/15/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			COPPINS, JANET L	
POST OFFICE BOX 1404			ART UNIT	
ALEXANDRIA, VA 22313-1404			PAPER NUMBER	
			1626	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,566

Applicant(s)

TAKEMOTO ET AL.

Examiner

Janet L. Coppins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 22-51 is/are pending in the application.
- 4a) Of the above claim(s) 25-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 50 and 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claims 1-3 and 22-51 pending in the instant application.

Response to Amendment

1. Receipt is acknowledged of Applicants' Response, filed August 20, 2004, which has been reviewed by the Examiner and entered of record in the file.
2. Accordingly, claim 1 has been amended and new claims 50-51 have been added. Claims 25-49 remain withdrawn from consideration.

Election/Restrictions

3. This application still contains claims 25-49, drawn to an invention non-elected with traverse in the Response of December 2, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. Claims 1-3 previously rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain cyclic, aryl, heteroaryl, or heterocyclic groups for Q' as discussed on page 6 of the specification, does not reasonably provide enablement for any and all cyclic, aryl, heteroaryl, or heterocyclic groups. In *In re Wands*, 8 USPQ2d 1400 (1988),

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factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described in the previous Office Action. Applicants have amended the claim to incorporate specific groups for the definitions of "cyclic group" however, the Examiner maintains the rejection because the terminology "saturated or unsaturated heterocyclic group" is still not enabled.

In the previous Office Action, the Examiner had recommended incorporating some of the cyclic groups that Applicants are enabled for in the specification, however Applicants have amended the claim to enable only a portion of the possibilities for the Q' variable. Applicants are claiming compounds and compositions according to formula (I). The specification has neglected to provide any working examples of compounds and compositions that contain any heterocyclic groups (other than benzothiazolyl and morpholinyl in the Examples and Table, pages 27-44). However, several examples are provided that describe phenyl, benzyl, and cyclopropyl moieties as suitable groups for the Q' variable. Claim I has still not been limited to the specific intended heterocyclic groups, therefore the quantity of experimentation would be undue to screen every possible type of heterocyclic group for the purposes of the instant invention. As stated previously, the Examiner suggests including some of the specific heterocyclic moieties listed on pages 6 and 27-44.

Claim Rejections - 35 USC § 102

6. Claims 1-3 and 22-24 previously rejected under 35 U.S.C. 102(e) as being anticipated by Annoura et al. In view of Applicants' persuasive arguments and the perfected claim for priority, the reference is not considered prior art and the Examiner withdraws the rejections to the claims.

Claim Rejections - 35 USC § 103

7. Claims 1-3 and 22-24 previously rejected under 35 U.S.C. 103(a) as being obvious over Annoura et al. In view of Applicants' persuasive arguments, for the reasons discussed above, the Examiner withdraws the rejections to the claims.

Double Patenting

8. Claims 1-3 and 22-24 previously rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. 6,559,146. Applicants contend that the instant amendment of claim 1 renders the claims patentably distinct from the claims of the '146 patent. The Examiner respectfully disagrees, since now, in their amended form, the instant claims are fully encompassed by the claims of the '146 patent. In fact, the only recited compounds that are *not* encompassed by the '146 patent are compounds wherein E² is -O- and R¹-R⁴ are methyl. Therefore the amendments to claim 1 do not differentiate the instant claims from claims 1-6 of the '146 patent, and the Examiner maintains the obviousness-type double patenting rejection to newly amended claim 1 as well as 2, 3, and 22-24.

Claim Objections

9. Claims 50-51 objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

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10. Claims 1-3 and 22-51 pending in the instant application. Claims 25-49 remain withdrawn from consideration. Claims 1-3 and 22-24 stand rejected. Claims 50-51 are objected to.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone Inquiry

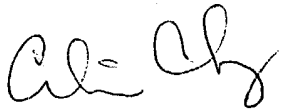
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins
November 30, 2004


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PRIMARY EXAMINER
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